

REMARKS

This is a full and timely response to the outstanding Office action mailed June 6, 2005. Upon entry of the amendments in this response claims 1, 2, 4-21, and 23-38 are pending. More specifically, claim 23 is amended. This amendment is specifically described hereinafter.

I. Present Status of Patent Application

Claims 1-2, 4-21, 23-28 are rejected under 35 U.S.C. § 103(a) as obvious over Duvall *et al* (U.S. Patent No. 5,884,033) in view of Katsikas (U.S. Patent No. 6,868,498 B1). Claim 23 is objected to because it depends on a canceled claim. These rejections are respectfully traversed.

II. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Vu spent with Applicant's Agents and Attorneys Jeff Kuester and Benjie Balser during an August 17, 2005 telephone discussion regarding the above-identified Office Action. Applicant believes that various features described in the patent application and recited in the claims, including a sender's email address and Duvall and confirming the recipient email address and Katsikas were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Vu seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Vu carefully consider this amendment and response.

III. Rejections Under 35 U.S.C. §103(a)**A. Claims 1-2 and 4-7**

The Office Action rejects claims 1-2 and 4-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Duvall* (U.S. Patent No. 5,884,033) in view of *Katsikas* (U.S. Patent No. 6,868,498 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
 - creating an incoming domain name list in a memory;
 - receiving an incoming email communication;
 - extracting a domain name from a sender's email address from the incoming email communication;*
 - storing the domain name in the incoming domain name list in the memory;
 - checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the incoming domain name list in the memory; and
 - transmitting the outgoing email communication if the domain name is included in the incoming domain name list, or otherwise *generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.*

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Duvall* and *Katsikas* does not disclose, teach, or suggest at least **extracting a domain name from a sender's email address from the incoming email communication**. The Office Action refers to a filter pattern in a URL in *Duvall* col. 5 line 65 – col.6 line 9, col. 6 line 60 – col. 7 line 8, col. 8 lines 48-61, col. 9 lines 47-64, col. 11 lines 60-64, and col. 12 lines 23-26. However, these citations refer to extracting a domain name from a URL. A URL is a User Resource Locator unrelated to the email address of the sender of an incoming email communication. Additionally, *Katsikas* does not make up for the deficiencies of *Duvall* noted above. Therefore, the rejection of claim 1 under a combination of *Duvall* and *Katsikas* is improper. For at least this reason, the rejection should be withdrawn and claim 1 should be

allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited references, dependent claims 2 and 4-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2 and 4-7 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2 and 4-7 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2 and 4-7 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2 and 4-7 are allowable.

B. Claims 8-17

The Office Action rejects claims 8-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Duvall* (U.S. Patent No. 5,884,033) in view of *Katsikas* (U.S. Patent No. 6,868,498 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 8 recites:

8. A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

receiving email communications incoming to the email communications server;
creating a domain name database;

***extracting domain names in senders' e-mail addresses from the e-mail
communications incoming to the email communications server;***

storing extracted domain names in the domain name database;
receiving outgoing e-mail communications from client computers connected to the
e-mail communications server through a local network;

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; and

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 8 is allowable for at least the reason that the combination of *Duvall* and *Katsikas* does not disclose, teach, or suggest at least **extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server**. The Office Action refers to a filter pattern in a URL in *Duvall* col. 5 line 65 – col.6 line 9, col. 6 line 60 – col. 7 line 8, col. 8 lines 48-61, col. 9 lines 47-64, col. 11 lines 60-64, and col. 12 lines 23-26. However, these citations refer to extracting a domain name from a URL. A URL is a User Resource Locator unrelated to the email address of the sender of an incoming email communication. Additionally, *Katsikas* does not make up for the deficiencies of *Duvall* noted above. Therefore, the rejection of claim 8 under a combination of *Duvall* and *Katsikas* is improper. For at least this reason, the rejection should be withdrawn and claim 8 should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 8 is allowable.

Because independent claim 8 is allowable over the cited references, dependent claims 9-17 (which depend from independent claim 8) are allowable as a matter of law for at least the reason that dependent claims 9-17 contain all the steps/features of independent claim 8. Therefore, the rejection to claims 9-17 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 8, dependent claims 9-17 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 9-17 are allowable.

C. Claims 18-20

The Office Action rejects claims 18-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Duvall* (U.S. Patent No. 5,884,033) in view of *Katsikas* (U.S. Patent No. 6,868,498 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 18 recites:

18. An e-mail server for automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

an interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications;

a database generator for generating a domain name database for storing domain names extracted from senders' e-mail addresses in incoming e-mail communications; and

a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications,

wherein the e-mail server detects misspelled domain names in e-mail addresses in outgoing e-mail communications.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 18 is allowable for at least the reason that the combination of *Duvall* and *Katsikas* does not disclose, teach, or suggest at least **an interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications**. The Office Action refers to a filter pattern in a URL in *Duvall* col. 5 line 65 – col.6 line 9, col. 6 line 60 – col. 7 line 8, col. 8 lines 48-61, col. 9 lines 47-64, col. 11 lines 60-64, and col. 12 lines 23-26. However, these citations refer to extracting a domain name from a URL. A URL is a User Resource Locator unrelated to the email address of the sender of an incoming email communication. Additionally, *Katsikas* does not make up for the deficiencies of

Duvall noted above. Therefore, the rejection of claim 18 under a combination of *Duvall* and *Katsikas* is improper. For at least this reason, the rejection should be withdrawn and claim 18 should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 18 is allowable.

Because independent claim 18 is allowable over the cited art of record, dependent claims 19 and 20 (which depend from independent claim 18) are allowable as a matter of law for at least the reason that dependent claims 19 and 20 contain all the steps/features of independent claim 18. Therefore, the rejection to claims 19 and 20 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 18, dependent claims 19 and 20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 19 and 20 are allowable.

D. Claims 21 and 23-25

The Office Action rejects claims 21 and 23-25 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Duvall* (U.S. Patent No. 5,884,033) in view of *Katsikas* (U.S. Patent No. 6,868,498 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 recites:

21. A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

creating an incoming email address list in a memory;

receiving an incoming email communication;

storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication;

checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory; and

transmitting the outgoing email communication if the e-mail address is included in the incoming email address list, or otherwise *generating a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.*

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the combination of *Duvall* and *Katsikas* does not disclose, teach, or suggest at least **storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication.** The Office Action refers to a filter pattern in a URL in *Duvall* col. 5 line 65 – col.6 line 9, col. 6 line 60 – col. 7 line 8, col. 8 lines 48-61, col. 9 lines 47-64, col. 11 lines 60-64, and col. 12 lines 23-26. However, these citations refer to extracting a domain name from a URL. A URL is a User Resource Locator unrelated to the email address of the sender of an incoming email communication. Additionally, *Katsikas* does not make up for the deficiencies of *Duvall* noted above. Therefore, the rejection of claim 21 under a combination of *Duvall* and *Katsikas* is improper. For at least this reason, the rejection should be withdrawn and claim 21 should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited art of record, dependent claims 23-25 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 23-25 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 23-25 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 23-25 are allowable.

E. Claims 26-28

The Office Action rejects claims 26-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Duvall* (U.S. Patent No. 5,884,033) in view of *Katsikas* (U.S. Patent No. 6,868,498 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 26 recites:

26. An e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

an address extractor for extracting senders' e-mail addresses from incoming e-mail communications;

a memory for storing e-mail addresses extracted from senders' e-mail addresses in incoming e-mail communications; and

a checker for searching the memory for e-mail addresses associated with intended recipients of the that are provided in outgoing e-mail communications,

wherein the checker generates a prompt for verification of the e-mail address upon detecting that an e-mail address in an outgoing e-mail communication is not present in the memory.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 26 is allowable for at least the reason that the combination of *Duvall* and *Katsikas* does not disclose, teach, or suggest at least **an address extractor for extracting senders' e-mail addresses from incoming e-mail communications**. The Office Action refers to a filter pattern in a URL in *Duvall* col. 5 line 65 – col.6 line 9, col. 6 line 60 – col. 7 line 8, col. 8 lines 48-61, col. 9 lines 47-64, col. 11 lines 60-64, and col. 12 lines 23-26. However, these citations refer to extracting a domain name from a URL. A URL is a User Resource Locator unrelated to the email address of the sender of an incoming

email communication. Additionally, *Katsikas* does not make up for the deficiencies of *Duvall* noted above. Therefore, the rejection of claim 26 under a combination of *Duvall* and *Katsikas* is improper. For at least this reason, the rejection should be withdrawn and claim 26 should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 26 is allowable.

Because independent claim 26 is allowable over the cited art of record, dependent claims 27 and 28 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27 and 28 contain all the steps/features of independent claim 26. Therefore, the rejection to claims 27 and 28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 26, dependent claims 27 and 28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 27 and 28 are allowable.

IV. Miscellaneous Issues

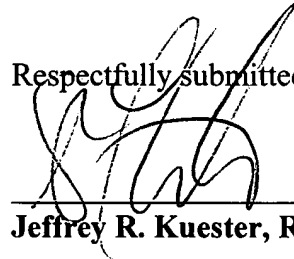
Claim 23 is amended to overcome the objection due to an incorrect dependency. Claim 23 now correctly depends from claim 21.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-38 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

Customer No.: 38823